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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,087	07/03/2003	Kazaya Katoh	24-007	5849

23400759009/07/2007

POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON, VA 20191

EXAMINER	
AHMAD, NASSER	

ART UNIT	PAPER NUMBER
1772	

MAIL DATE	DELIVERY MODE
09/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/612,087	KATOH ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,9 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-7,9 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. Claims 2, 7, 9, 15, 19, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Moreno (US 20040053044A1) made in the Office Action of 3/22/2007 has been withdrawn in view of the amendment filed on 6/19/2007.
2. Claims 4-6, 16-18, 20, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno made in the Office Action of 3/22/2007 has been withdrawn in view of the amendment filed on 6/19/2007.

Response to Arguments

3. Applicant's arguments with respect to claims 2, 4-7, 9 and 15-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2, 7, 9, 15, 19, 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Moreno (US 20040053044A1).

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Moreno relates to a laminate sheet comprising a plurality of adhesive sheet portions (20) having a predetermined form, formed from an adhesive sheet laminated on a long release sheet (12, coated with LAB, paragraph-[0027]), and a protective member (18) laminated on the long release sheet. The protective member is thicker than said adhesive sheet and is provided longitudinally on the release sheet and spaced apart from the adhesive sheet (figure-3) portions so as not to overlap said adhesive sheet portions. The adhesive sheet portions are provided longitudinally in a central portion of the release sheet (figure-3) and the protective member is provided on both side portions of said release sheet in the direction of the width of the release sheet. It is well known in the art to provide the LAB on a release sheet, when the adhesive sheet is formed into a roll. The adhesive sheet comprises a base material and an adhesive layer, when the tape is formed into a roll (wherein the tape is rolled onto itself) with the adhesive (20) being located between the LAB coated sheet (12) and the adjacent layer of the sheet (12) in the roll. In the alternative, the base material and adhesive would form a thicker layer when the base material and the adhesive are of the same composition (applicant has not shown otherwise).

For claim 7, the adhesive sheet comprises a base material of a resin sheet (paragraph-[0023]).

For claim 9, the tape is formed into a roll as the LAB on its rear surface provides for the ability to unroll.

For claims 15, 22 and 23, as shown in figure-1, the adhesive sheet portions have a size and form. However, the phrase "that substantially conforms to the surface of an optical

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disc” has not been given any patentable weight because it is directed to an intended use and is not a positive limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6, 16-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno.

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Moreno, as discussed above, fails to teach that the protective member is shaped to intrude between the adhesive sheet so as to partially overlap the adhesive sheet.

However, figure-1 of Moreno is interpreted to partially overlap the adhesive sheet as the thicker edge portion overlaps the side edge of the adhesive sheet. The shape of the edge member appears to be a straight line and not intruding between the adhesive sheet portions. Therefore, it would have been obvious to one having ordinary skill in the art to modify Moreno's thicker edge member to have a shape such that it intrudes between the adhesive sheet portions because it would have involved a mere change in the shape of the component. A change in shape is found to be within the level of ordinary skill in the art.

For claim 5, the edge member can be 2-20 mils (paragraph-[0018]).

For claim 6, the surface of the overlapping part is not more than 50% of the surface area of the adhesive sheet (because the edge of the adhesive sheet appears to be not more than 50% of the surface area of said sheet).

For claim 18, the tape is formed into a roll as the LAB on its rear surface provides for the ability to unroll.

Response to Arguments

8. Applicant's arguments filed 6/19/2007 have been fully considered but they are not persuasive.

Applicant argues that Moreno fails to teach the claims as amended in the amendment filed on 6/19/2007. This is not found to be convincing because as explained hereinabove

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rejections, Moreno teaches the presence of a base material with the adhesive being located between the base material and the release sheet when the tape is formed into a roll such that the release sheet of the adjacent layer in the roll is interpreted to be the base material and the adhesive layer is then located between the base material and the release sheet. In the alternative, in the absence of any teaching otherwise, the adhesive material and the base material can be the same and hence, form a thicker adhesive sheet portion with the adhesive layer being located between the base material and the release sheet.

In response to applicant's argument for claim 2, it is well known in the adhesive tape art to provide an elongated tape with adhesive thereon both lengthwise and widthwise.

Hence, what applicant is referring to in the drawing of Moreno is showing the side/end view of the tape and not its plan view.

For applicant's argument that Moreno's adhesive adhesives (18) and (20) are not spaced apart, applicant is directed to figures 3 and 4 in Moreno which shows the spaced apart feature, while figure-1 shows that the adhesive (18) and (20) have a separation line therebetween, which is taken to provide for spacing between said adhesives.

As for claims 15, 22 and 23, applicant is directed to the above rejections wherein the intended use limitation has been explained as being directed to the future use of the claimed laminate with an optical disc.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed hereinabove.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

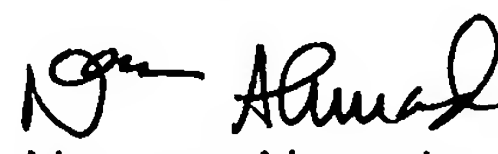
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 9/4/07
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
September 4, 2007.